



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/351,399	07/13/1999	AKIRA OGINO	450100-4982	9658

20999 7590 06/25/2003

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

REAGAN, JAMES A

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/351,399

Applicant(s)

OGINO ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 13-15, 20-24, 32-36, 44-46 and 51-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13-15, 20-24, 32-36, 44-46, and 51-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment and RCE received on 21 April 2003.
2. Claims 1, 4, 5, 13, 20, 23, 24, 32, 35, 36, 44, 51, 54, and 55 have been amended (paper #18).
3. Claims 6-12, 16-19, 25-31, 37-43, 47-50, and 56-62 have been cancelled (paper #18).
4. Claims 1-5, 13-15, 20-24, 32-36, 44-46, and 51-55 have been examined.

RESPONSE TO ARGUMENTS

5. Applicant's arguments received on 21 April 2003 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
6. With regard to the limitations of claims 1-5, 13-15, 20-24, 32-36, 44-46, and 51-55, Applicant argues that the passages cited by the Examiner do not specifically disclose *an output means for supplying the information on copyright protection encrypted by the encryption means and the unencrypted information on copyright protection*.

Specifically, Applicant states that all of the copyright information is provided in both encrypted and unencrypted forms. After reviewing the claim language and the arguments presented by the Applicant, it appears to the Examiner that the intent of the claims is to provide a method and system that transmits two identical streams of copyright information, the only difference is that one stream is encrypted and one stream is not. Schneck discloses transmitting some of the information in an encrypted form, and some of the information in an unencrypted form. Therefore, It would obvious to one of ordinary skill in the art at the time of the claimed invention to modify Schneck include complete copyright protection information in both an encrypted and unencrypted form separately and simultaneously for the purposes of redundancy. Naturally, if a method or system included a step to encrypt a data stream, it would be an obvious modification to exclude that same step in order to transmit the same information in an unencrypted form. A person of rudimentary skill in the art would need to look no further than a common walkie-talkie set that has a an encryption switch for turning the encryption algorithm on and off. Obviously, using the standards of modern technology, exporting information by either encrypting it or by not encrypting it would be equally as plausible and possible as simulcasting both parts.

Previous Claim Rejections - 35 USC § 112

7. Claims 4, 5, 23, 24, 35, 36, 54, and 55 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner would like to

thank the Applicant for correcting the deficiencies within the claims. The rejection to claims 1-5, 13-15, and 44-46 under 35 U.S.C. 112 is hereby withdrawn.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5, 13-15, 20-24, 32-36, 44-46, and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-65662 (JP `662 hereinafter) in view of Schneck et al. (Schneck hereinafter: US PAT. 6,314,409 B2) and Ryan et al. (Ryan hereinafter: US PAT. 6,374,036 B1).

Claims 1, 13, and 20:

JP `662 discloses an information signal playback system having all of the features claimed except for the explicit disclosure of (a) the output means for supplying the information on copyright protection encrypted by the encryption means and the unencrypted information on copyright protection and the main information signal on which copy control information is embodied to the information signal processing apparatus and (b) a watermark detecting means: see an attached figure. However, Schneck discloses the output means for supplying the information on copyright protection encrypted by the encryption means and the unencrypted information on

copyright protection and the main information signal on which copy control information is embodied to the information signal processing apparatus and copy control information for a system to control access and distribution of digital property (e.g., Abstract; col. 7, lines 22-50; col. 10, lines 47-65; col. 13, lines 58-62; col. 23, lines 25-27). Further, Ryan discloses the use of watermark for controlling copy of a digital video signal. Thus, it would have been within the level of ordinary skill in the art to modify the system of JP `662 by adopting the teachings of Schneck and Ryan to enhance the functions of the claimed system by providing additional copy protection features.

Claims 32, 44, and 51:

None of JP `662, Schneck and Ryan explicitly discloses the claimed methods. However, it would have been obvious to operate the system, which would have been obvious as stated supra.

Claims 2, 14, 21, 33, 45, and 52:

Both Schneck (e.g., col. 18, lines 11-17) and Ryan (e.g., col. 2, lines 30-35) disclose that the information on copyright protection is media-type information indicating the type of the recording medium. Thus, it would have been within the level of ordinary skill in the art to modify the apparatus and method of JP `662 by adopting the teachings of Schneck and Ryan to provide better control of reproduction of the information to the claimed apparatus and method.

Claims 3, 15, 22, 34, 46, and 53:

JP `662 does not explicitly disclose the use of CSS system. However, CSS system is one of old and well-known recording and reproducing system and nothing

unobvious is seen to have been involved simply having employed this well known system for an information signal playback system of the sort here involved.

Claims 4, 5, 23, 24, 35, 36, 54, and 55:

None of JP `662, Schneck and Ryan explicitly disclose the use of additional information (additional digital watermark information). However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to any desirable number of digital watermark information, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With regard to the limitation of never-copy or copy once implementations, Ryan discloses using a watermark to enable copy once or never copy permissions for a digital work (abstract and related text). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the copy permissions of Ryan because providing a means for controlling the unauthorized distribution of digital works, "...offers improved security and economics" (Ryan, column 2, lines 30-32).

Art Unit: 3621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including..

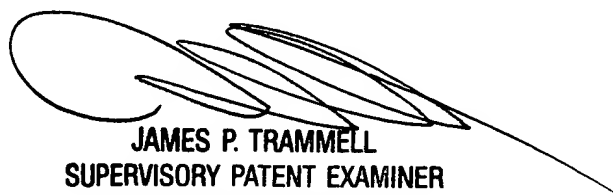
After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

18 June 2003


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600